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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,635	07/02/2003	Craig W. Ball	P05769US01	4611
22885	7590	04/03/2006	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C.			TRAN, KHOI H	
801 GRAND AVENUE			ART UNIT	
SUITE 3200			PAPER NUMBER	
DES MOINES, IA 50309-2721			3651	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/613,635

Applicant(s)

BALL ET AL.

Examiner

Khoi H. Tran

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

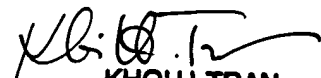
**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/02/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
KHOI H. TRAN  
PRIMARY EXAMINER

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. This application filed under former 37 CFR 1.62 lacks the necessary reference to the prior application. A statement reading "This is a divisional of Application No. 10/235,882, filed September 5, 2002" should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of the parent nonprovisional application should be included.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stapling means and the stapling step must be shown or the feature(s) canceled from the claim 3. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The second positive recitation of " a shipping label" renders the claim indefinite because it is not known whether this shipping label is different than the one positively identified in claim 1.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128.

Schuricht et al. '132 disclose all elements per claimed method: receiving an intended delivery location with each of a plurality of documents (column 2, lines 55-68); determining a time required to deliver each document to the intended delivery location

(column 3, lines 17-21); determining a desired date of receipt (column 9, lines 64-66); printing each document to allow for the time required to deliver each document on the desired date of receipt (column 10, lines 4-10); obtaining shipping data for each document and printing a label for each document. However, Schuricht '132 is silent as to the specifics of printing the shipping label in-line with printing documents for subsequent mailing.

Harris et al. '128 disclose method of printing mailing labels in-line or on-line with printing documents to be mailed is known (Figure 1, column 3, lines 46-54, paragraph bridging columns 3 and 4, column 8).

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have generated Schuricht '132 label in-line or on-line with printing documents to be mailed, as taught by Harris et al. '128, because it facilitates known means for generating labels for mailing documents.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuricht et al. 5,040,132 in view of Harris, Jr. et al. 5,114,128 as applied to claim 1 above, and further in view of Boss 4,770,284.

Schuricht et al. '132 modified method discloses all elements per claimed invention. However, it is silent as to the specifics of stapling a shipping label to the document.

Boss '284 teaches name and address can be applied to mailing documents by ink jet printer, or it can be applied first to a label which is to be pasted, stapled or affixed

to the mailing documents. Boss '284 shows that stapling shipping label to mailing documents is commonly well known.

It would have been obvious for a person with ordinary skill in the art, at the time the invention was made, to have stapled Schuricht et al. '132 shipping label to the mailing documents because it facilitates another commonly well known means of affixing shipping label to mailing documents, as taught by Boss ' 284.

### ***Response to Arguments***

8. Applicant's arguments filed 01/20/2006 have been fully considered but they are not persuasive.

Applicant argued that Harris, Jr. et al. 5,114,128 only disclose a method of printing off line. This argument is not persuasive. Applicant's attention is directed to at least the referred excerpts in paragraph 6 above. Harris Jr. et al. '128 teach that both on-line and off-line printing of labels and documents are known.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, it is the well-known teaching of on-line printing of shipping labels with printing documents that provides the motivation to combine the references.

***Conclusion***

9. Additional reference(s) made of record and not relied upon are considered to be of interest to applicant's disclosure: see attached USPTO Form 892.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoi H. Tran whose telephone number is (571) 272-6919. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khoi H Tran  
Primary Examiner  
Art Unit 3651

KHT  
03/30/2006